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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,373	02/15/2002	Donald A. Soboleski	1999-012-02US	4280

7590 10/19/2005

PARTEQ Innovations
Room 1625, Biosciences Complex
Queen's University
Kingston, ON K7L 3N6
CANADA

EXAMINER

RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,373

Applicant(s)

SOBOLESKI ET AL.

Examiner

Anu Ramana

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/29/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 13, 17 and 19-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-28 is/are allowed.
- 6) ☒ Claim(s) 12, 13, 17 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/12/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-13, 17 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Zucherman et al. (US 5,836,948).

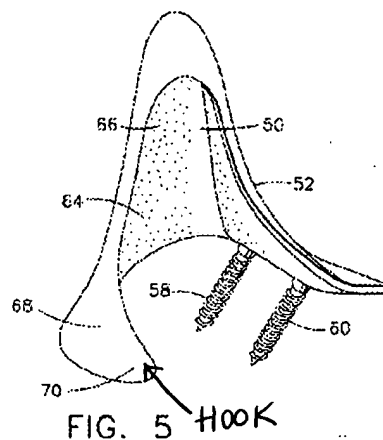
Zucherman et al. disclose an implant or "spinal facet cap" having a shim portion 560 that is wedge-shaped in that it has a thick and a thin portion and an alignment portion including two "facet hooks" 554 and 556 wherein the hooks can be made of flexible material and thus the relative distance between the hooks is adjustable (Figs. 67 and 68, col. 13, lines 56-67 and col. 14, lines 1-23).

The introductory statement and all other functional statements of intended use have been carefully considered but are deemed not to impose any structure on the claims distinguishable over the Zucherman et al. implant which is capable of functioning as a spinal facet cap as claimed.

Claims 12 and 29-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Fitz (US 5,571,191).

Fitz discloses a "spinal facet cap" having a wedge-shaped shim portion, an alignment portion with a boss, a tongue having an orifice and a facet hook (Figures 3 and 5, col. 2, lines 61-67 and col. 3, lines 1-54). See marked up Figures 3 and 5.

FIG. 3 is a perspective view of the device. It shows the tongue (32) and the boss (50). The boss (50) is a circular component with a central opening. The tongue (32) is a large, irregularly shaped component that fits around the boss. Various components are labeled with numbers: 52, 54, 56, 58, and 60. The tongue (32) is shown in a position where it is being inserted into the boss (50).



Reiley discloses a prosthesis or “spinal facet cap” 700 with a shim portion that is wedge shaped in that it tapers to a thinner portion and an alignment portion with a facet hook (Figures 22 and 23). See marked up Figure 22 below.

FIG. 1 is a perspective view of a hook and tongue fastener assembly. The assembly includes a rectangular plate 700 with two circular holes 742 and 741. A tongue 725 is attached to the plate, featuring a hook 726 at its end. A boss 705 is located on the tongue. The tongue is shown in a bent position, engaging the hook.

Allowable Subject Matter

The indicated allowability of claims 12, 13, 17 and 29-33 is withdrawn in view of the rejections made in this office action. Accordingly, the finality of the office action mailed on January 4, 2005 has been withdrawn. The amendment filed on June 7, 2005 has been entered.

Claims 19-28 are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anu Ramana*
October 17, 2005


EDUARDO C. ROBERT
PRIMARY EXAMINER